UNITED STATES PATENT AND TRADEMARK OFFICE

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ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 April 2004*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _36-50_ is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _36-50_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All b)☐ Some * c)☐ None of:

  1.☐ Certified copies of the priority documents have been received.

  2.☐ Certified copies of the priority documents have been received in Application No. _____.

  3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.　Request for reconsideration, paper number 22, received on April 01, 2004 is acknowledged. None of the existing claims 36-50 has been amended. Currently claims 36-50 are pending for examination.

Response to Arguments

2.1　Applicant's arguments filed on April 01, 2004, concerning rejection of claims 36-40 under 35. U.S.C. 101 have been fully considered but they are not persuasive for following reasons:

(i) The applicant refers to State Street Bank decision and argues that for an invention to fall into a statutory class must also satisfy the useful requirement of 35 U.S.C.101 and further concludes that claims 36, 37, and 39 have practical utility, i.e., paying a bill on behalf of a consumer by maintaining a database.....add information to a master merchant file database (see remarks, page 2, line 4-page 4, line 1). The examiner disagrees. The standard for the practical application as per State Street Bank decision is the " **production of a useful, concrete and tangible result**".

In State Street Bank decision, the patented claims recited using a machine (computer) which makes a series of mathematical calculations to transform data, representing discrete dollar amounts, into a final share price thus constituting a practical application which is useful in the production of "a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and ins subsequent trades ". **The**

aspect that the production of a final share price is assured and reproducible by using a

machine (computer) programmed to transform data which represents discrete dollar amounts

into a final share price does constitute that the invention is "concrete". However, in the instant

application, claims 36-40 do not recite a use of a machine which is programmed to implement

the manipulative steps of searching, determining, adding and processing. The limitations of

searching, determining, adding and processing without the use of a machine (computer) which

is programmed to carry out the intended steps constitute a mere abstract idea, which at best is

speculative, and would require undue experimentation to realize it, produce and reproduce it as

assured in the patented claims of State Bank decision.

In determining if the claim produces a tangible result, the examiner refers to the following

holding in *In re Warnerdam,* 33 F.3d 1354; 31 USPQ2d 1754 (Fed, Cir, 1994), whether there is

simply a mathematical or abstract construct claimed, such as disembodied data structure and

method of making it. If so, the claim involves no more than a manipulation of an abstract idea

and therefore is nonstatutory under 35 U.S.C. 101. In contrast, a claimed computer-readable

medium encoded with a data structure and the computer software and hardware components

which permit the data structure's functionality to be realized is statutory subject matter subject to

the requirements for utility. In the State Street Bank decision, the generated final share price

using a machine (programmed computer) is tangible because the programmed machine

(computer) permits the data structure's functionality to be realized and is therefore a statutory

subject matter. However, in the instant application the claims do not recite the use of

technology, such as a programmed machine (computer), which can permit to realize the

functionality of the manipulative steps and thereby rendering the invention intangible.

The applicant argues, " Notwithstanding the fact that 35 U.S.C. 101 does not require that

claims be directed to computers.....indicate any connection to a computer or technology " (see

page 3, remarks). In response, the examiner would like to point out that since the claims did not

recite technological arts he suggested use of a computer and computerized processing (see

State Street Bank decision) to overcome the rejection of claims 36-40 under U.S.C. 101. In this

context, the examiner also draws attention to *In re Toma,* 197 USPQ 852 (CCPA 1978)

decision, as quoted on page 3, line 19-page 4, line 6 in the previous office action, wherein the

court held that the claimed computer implemented process was within the "technological art".

Further, in *In re Alappat,* 33 F.3d 1354 (Fed.Cir.1994) the court also held that the physical

requirement of the *Freeman-Walter-Abele test* is met by a programmed general-purpose

computer as a patentable subject matter.

In view of the above, when comparing the claims 36-40 of the instant application with the

patented claims in State Street Bank decision they do not recite use of technology and hence

are not capable of " producing a useful,   concrete, and tangible result".

ii) The applicant argues (page 3, lines 15-24) that it will be obvious to one of ordinary

skill in the art in view of the Microsoft Computer dictionary that that each of the method claims

recites the terms "database" and "processing" and therefore, at least in part, utilizes a computer.

The examiner disagrees for the following reasons:

The broad meanings of the terms "database" and " processing", see Merriam-Webster's

Collegiate Dictionary (Webster), 10th edition, pages 293 and 929 do not inherently imply the use

of computer. As per Webster, database (1962) is a large collection of data. There may not be a

need of a computer when you are dealing with data collected in mind, or paper. As per Webster,

use of a computer is used only when rapid search and retrieval of data is required. Similarly, the

term " processing" (1532) in its broad sense means to subject to a process or treatment through

a routine procedure in manufacturing or handling of insurance claims, etc. and there may be no

need of computer.

The applicant argues, "It would be understood by anyone of ordinary skill in the art that each of these claims is directed to methods performed, at least in part, utilizing a computer. .... Processing is the vital step between receiving data (input) and producing results (output) - the task for which computers are designed" (see page 3 remarks). From these remarks, it appears that the applicant intends to use computerized processing and if that is so, incorporation of computerized processing (which is technology) in the claims to realize the manipulative steps would overcome 35 U.S.C. 101 rejection.

In view of the foregoing, the rejection of claims 36-40 under 35 U.S.C. 101, as presented in the previous office action, is maintained.

2.2   Applicant's arguments filed on April 01, 2004, concerning rejection of claims 36-50 under 35. U.S.C. 103 (see remarks, pages 4-7), have been fully considered but they are not persuasive for following reasons:

(i) The applicant argues (see page 5, lines 4-21 of the Response) that, " Lawlor lacks any disclosure of a master database of merchants or a database of merchants containing merchants received from or identified by multiple customers" and " Thus, Lawlor explicitly teaches only a user-specific merchant file and lacks any disclosure whatsoever of a master merchant file, i.e. a file which includes merchants identified by multiple users or consumers". The examiner respectfully disagrees. Lawlor does disclose a master database "84" (see at least FIG.1A), which, as per col.14, lines 7-9, col.19, lines 19-53, and col.33, lines 24-34, is a mass storage device and with the programmed machine (computer) implements the bill paying functions, and retrieval of bill payer and payee information retained in the database "84". The bill payment services are catered to a plurality of customers having a plurality of vendors (see col.10, lines 66-69, " *To use bill paying features, customers provide the service provider in*

advance with a **list of payees** [names, account numbers, addresses]....". Note: The term

"payees" in Lawlor corresponds to merchants or vendors.). From these segments of Lawlor, it is

clear that Lawlor discloses a master database "84" which includes plurality of merchants, their

information is identified by multiple users and this information about merchants is used for bill

payment on behalf of multiple users.

(ii) The applicant further argues that Lawlor does not teach searching even a user-

specific payee list (see page 5, line 22 of the Response). The examiner does not agree because

Lawlor in Col.43, lines 25-46, "..*a different payee is displayed on each of these lines to permit

the user to select a desired payee by depressing one of select keys 108 pointing to the

displayed payee name. ..... Thus, blocks 516-522 may be visualized as defining a 4-line long

"window" scrolling up and down through a user payee list that may be of any desired length. If

the user reaches the end of his payee list without making a payee selection, block 524 is

programmed to return to the beginning of the bill process routine 392 shown in FIG. 13.* "; does

teach searching a list of plurality of merchants to check if the desired merchant is available in

the list[In Lawlor "payee" corresponds to a merchant] and then select that vendor for bill

payment. Lawlor teaches that while searching the list of merchants, if the required merchant is

not found, the consumer does not select a merchant and then is returned to the beginning of the

bill process routine 392.

(iii) The applicant argues (see page 6 in Response) that the reference White is not in the

same field of art as Lawlor or of the present invention and that it does not disclose that a

software adds a payee based upon received information because the user manually adds the

payee. The examiner respectfully disagrees for the following reasons:

(a) White's art is related to bill paying because it discloses the use of an accounts

payable module to disburse payments to the vendors (see page 3, line 57-page 4, line 13).

(b) White's art is reasonably pertinent to the particular problem, of adding vendors

(merchants in the instant applicant) to the system when found that the particular vendor is not

included in the system to implement a bill payment, with which the inventor was concerned. See

MPEP 2141.01(a) Analogous and Nonanalogous Art -TO RELY ON A REFERENCE UNDER 35

U.S.C. 103, IT MUST BE ANALOGOUS PRIOR ART......." *In re Oetiker*, 977 F.2d 1443, 1446,

24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ

313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992)

("A reference is reasonably pertinent if, even though it may be in a different field from that of the

inventor's endeavor, it is one which, because of the matter with which it deals, logically would

have commended itself to an inventor's attention in considering his problem."); and *Wang*

Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

(c) White's reference explicitly discloses adding the vendor (merchant in the instant

application) by using an accounts payable software module, see paragraph 4, page 3, *The*

accounts payable (and accounts receivable, as well) module has a handy feature that

allows you to add a vendor ......the system immediately displays a vendor add screen....". Note:

The accounts payable module, i.e., a software helps to search and detect if the required vendor

is included in the system and if found to be not included the module is configured to add the

vendor to the system. The vendor cannot be added manually to a software system. On being

prompted by the module, the user enters the vendor's name and then the software module,

which is configured, adds the entered vendor to the system.

In view of the above, the combination of Lawlor and White is proper and teaches

determining/searching and adding of merchant as required by independent claims 36, 37, and

39, storage device "84" and processor (central computer 52) as required by independent claims

41, 42, and 44 and software/programming which causes a computer to make the searching/

determination if vendor is included or not and if not processing to add vendor as required by the

independent claims 46, 47 and 49.

(iv). The applicant argues (see page 7, Response) concerning claim 38 that Lawlor in

view of White does not disclose the limitation of adding a merchant to a merchant file in

conjunction with a request for payment. In response to applicant's argument that the references

fail to show certain features of applicant's invention, it is noted that the features upon which

applicant relies (i.e., adding a merchant to a merchant file in **conjunction with a request for**

payment) are not recited in the rejected claim(s). Although the claims are interpreted in light of

the specification, limitations from the specification are not read into the claims. See *In re Van*

Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In claim 38 the steps of receiving

request and adding a merchant are two separate steps and do not recite the limitation that

adding of the merchant is done in response to a request for payment by the consumer. As per

the recited limitations of claim 38 searching of the master file and adding merchant can be done

prior to receiving a request for payment.

(v) In view of the above analysis, the applicant's arguments regarding the rejection of

claims 40, 43, 45, 48, and 50, are also not persuasive.

In view of the foregoing, the rejection of claims 36-50 under 35 U.S.C. 103(a) as being

unpatentable over Lawlor in view of White is maintained.

This is a Final office action.

Claim Rejections - 35 USC § 101

3.   **35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 36-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See In re Musgrave, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See Diamond v. Diehr, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See State Street Bank & Trust Co. v. Signature Financial Group, Inc. 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See In

re Toma, 197 USPQ (BNA) 852 (CCPA 1978). In Toma, the court held that the recited

mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-

Walter-Abele test as applied to Gottschalk v. Benson, 409 U.S. 63, 175 USPQ (BNA) 673

(1972). Additionally, the court decided separately on the issue of the "technological arts". The

court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject

matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not

on whether the prior art which the claimed subject matter purports to replace...is statutory, and

not on whether the claimed subject matter is presently perceived to be an improvement over the

prior art, e.g., whether it "enhances" the operation of a machine. In re Toma at 857.

In Toma, the claimed invention was a computer program for translating a source human

language (e.g., Russian) into a target human language (e.g., English). The court found that the

claimed computer implemented process was within the "technological art" because the claimed

invention was an operation being performed by a computer within a computer.

The decision in State Street Bank & Trust Co. v. Signature Financial Group, Inc. never

addressed this prong of the test. In State Street Bank & Trust Co., the court found that the

"mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to

determining the presence of statutory subject matter but rather, statutory subject matter should

be based on whether the operation produces a "useful, concrete and tangible result". See State

Street Bank & Trust Co. at 1374. Furthermore, the court found that there was no "business

method exception" since the court decisions that purported to create such exceptions were

based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the

court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged

under °101, but rather under §§102, 103 and 112." See State Street Bank & Trust Co. at 1377.

Both of these analysis goes towards whether the claimed invention is non-statutory because of

the presence of an abstract idea. Indeed, State Street abolished the Freeman-Walter-Abele test used in Toma. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in Toma because the invention in State Street (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the Toma test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See Ex parte Bowman, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, Claims 36-40 have no connection to the technological arts. None of the steps indicates any connection to a computer or technology. The step of receiving a request to pay a bill associated with a merchant on behalf of a consumer over a network could be performed manually by a person physically delivering the bills to a "network" of bill handlers or service providers. The term "network" could also include sending the bills through the US Postal network, using a courier service such as UPS to deliver the brand promotions through its network of carriers, etc. Further, limitations such as searching a master merchant file database and adding merchants to a master merchant file database could be performed manually by searching a list of merchants in a paper file and adding new merchants to this paper file. Similarly processing the request to generate an instruction to pay the bill can be performed manually by issuing instructions to manual workers to pay the bills by mailing checks to payees. Therefore, the claims are directed towards non-statutory subject matter. To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify which of the steps are being performed within the technological arts, such as incorporating a computer network or electronic network , electronic database, and computerized processing of the requests; for example: " receiving, via electronic network or a computer network , a request to pay a bill associated with a merchant on behalf of a consumer;

determining if the merchant is included in an electronic master merchant file database .....".

The other limitations/claims could be similarly amended to include a computer/electronic

network and electronic database.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 36-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor in

view of White.

Regarding claim 36, Lawlor teaches a method for paying bills (see at least abstract and

col.6, lines 37-44, "......In particular, the present invention provides a practical, cost-effective,

workable system and method for delivering banking and other financial services (including

billpaying capabilities) *to remote sites such as customer homes and offices ......* "),

comprising the steps of:

receiving, via a network, a request to pay a bill associated with a merchant

on behalf of a consumer;

processing the request to generate an instruction to pay the bill

(For the above limitations, see at least col.7, lines 5-24, "*An asynchronous communications link*

*is connected to a telephone company **public data network (or other digital packet network)***

between the remote terminal and a central computer system operated by the service provider.

*A central computer system analyzes and processes the user payment instructions--**typically***

***processing a user's request for many discrete financial transactions at one time.** The*

central computer stores information about these transactions in a database it maintains; and

then generates electronic funds transfer (EFT) requests which it communicates to the user's

bank via an ATM network/switch. For example, the central computer system may debit the

user's account at his bank (e.g., via a POS debit message passed over the ATM network) and

electronically transfer the funds to a holding account or bank. The central computer then

***distributes the funds (bill payments) to the payees** requested by the user.* ". Note: the

central computer receives the requests from consumer for bill payments associated with

payees. The payees, in Lawlor, correspond to the merchants to whom the bill payments are to

be distributed.);

determining if the merchant is included in a master merchant file database (see at least

col.12, lines 21-26, " .... *Most costs are incurred in responding to user inquiries, correcting*

*payee posting errors, **maintenance of payee databases**, ...* ". See also col.14, lines 7-9,

col.33, lines 24-34, col.33, lines 51-60, " *... The payee/vendor information file is accessed to*

determine his status, electronic or paper payment..... ", and col.43, lines 20-22, "*.....If desired,*

the initial listing displayed by block 516 may constitute a listing of categories of payees

rather than individual payees.... " . Note: As analyzed above the payees, in Lawlor,

correspond to the merchants. Here, Lawlor explicitly discloses maintaining master merchant file

database. Lawlor's disclosing of a category of payees instead of individual payees shows that

Lawlor maintains a master merchant file database applicable to all users. Further, in Col.43,

lines 25-46, ["*In the preferred embodiment, a different payee is displayed on each of these lines*

to permit the user to select a desired payee by depressing one of select keys 108 pointing to the

displayed payee name. Generally, then, a particular user will have a longer list of payees than

may be displayed on display 102 simultaneously. If the user does not select one of the

displayed payees (e.g., by either not depressing one of select keys 108 or by pressing the

PRIOR or NEXT key 104,106) (as tested for by decision block 518), central computer 52

attempts to display the "next" or "previous" 4-payee sublist of the user's payee list (decision

block 520,522,516). Thus, blocks 516-522 may be visualized as defining a 4-line long "window"

scrolling up and down through a user payee list that may be of any desired length. If the user

reaches the end of his payee list without making a payee selection, block 524 is programmed to

return to the beginning of the bill process routine 392 shown in FIG. 13. ".] Lawlor discloses

allowing the user to select a payee and if the payee is not found from the displayed list the user

is returned to the beginning of the bill process routine. While the user is looking at the displayed

list of payees retrieved from the master merchant file database he mentally determines if the

required payee/merchant is there or not and if the merchant is not there he does not select the

payee from the displayed list and finally returned to the beginning of bill pay routine..).

Lawlor does not expressly discloses adding the merchant to the master merchant

file database if the merchant is determined to be not included in the master merchant file database. However, White, in the same field of bill payments, discloses the use of a software which teaches adding the merchant to the master merchant file database if the merchant is determined to be not included in the master merchant file database. (see at least marked page 4, lines 21-32, " *The accounts payable (and accounts receivable, as well) module has a handy feature that allows you to add a vendor (or customer) "on the fly." For example, if you are in the bills payable function and find that you need to enter an invoice for a vendor not yet established in you vendor file, you are not required to exit the bills payable function in order to use the vendor maintenance function to add that vendor. You enter the new vendor's name, and the system will display the message " Vendor not on   file--do you wish to add it?" When you answer yes, the system immediately displays a vendor add screen. When you finish entering the appropriate data, the system returns you to the bills payable function. This type of feature, though not truly an accounting function, sure does make the system more accommodating to the small-business environment. ").* In view of White, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to have modified Lawlor to incorporate White's teachings of adding the merchant to the master merchant file database if the merchant is determined to be not included in the master merchant file database. Doing so makes the system more convenient, efficient and faster as one does not have to exit from the bill paying routine to update the master merchant filed database and then enter again the bill paying routine.

Regarding claim 37, Lawlor teaches a method for maintaining a master merchant file database (see at least col.12, lines 21-26, " ....*Most costs are incurred in responding to user inquiries, correcting payee posting errors, **maintenance of payee databases**, ... *". See

also col.14, lines 7-9, col.33, lines 24-34, col.33, lines 51-60, " ... *The payee/vendor information file is accessed to determine his status, electronic or paper payment.....* ", and col.43, lines 20-22, "*.....If desired, the initial listing displayed by block 516 may constitute a listing of categories of payees rather than individual payees....* " . Note: As analyzed above the payees, in Lawlor, correspond to the merchants. Here, Lawlor explicitly discloses maintaining master merchant file database. Lawlor's disclosing of a category of payees instead of individual payees shows that Lawlor maintains a master merchant file database applicable to all users.), comprising the steps of:

receiving a list identifying merchants from a consumer (see at least col.10, lines 66-68, "*To use billpaying features, customers provide the service provider in advance with a list of payees (names, account numbers, addresses).* ";

Lawlor further teaches maintaining and updating merchant databases (see at least col.12, lines 21-26, " ....*Most costs are incurred in responding to user inquiries, correcting payee posting errors, maintenance of payee databases, ...*"and col.20 and lines 40-43) and that the said databases include information associated with merchants that has been received from other consumers (col.43, lines 20-22, "*.....If desired, the initial listing displayed by block 516 may constitute a listing of categories of payees rather than individual payees....* " . Note: As analyzed above the payees, in Lawlor, correspond to the merchants. Here, Lawlor explicitly discloses maintaining master merchant file database. Lawlor's disclosing of a category of payees instead of individual payees shows that Lawlor maintains a master merchant file database applicable to all users/consumers.).

Lawlor does not expressly discloses searching a master merchant file database to determine if information associated with one of the identified merchants is included in the master merchant file database and adding information associated with the one identified

merchant to the master merchant file database if information associated with the one identified

merchant is determined not to be included in the master merchant file database.

However, White, in the same field of bill payments, discloses searching a master merchant file

database to determine if information associated with one of the identified merchants is included

in the master merchant file database and adding information associated with the one identified

merchant to the master merchant file database if information associated with the one identified

merchant is determined not to be included in the master merchant file database (see at least

marked page 4, lines 21-32, " *The accounts payable (and accounts receivable, as well) module*

has a handy feature that allows you to add a vendor (or customer) "on the fly." For example, if

you are in the bills payable function and find that you need to enter an invoice for a vendor not

yet established in you vendor file, you are not required to exit the bills payable function in order

to use the vendor maintenance function to add that vendor. You enter the new vendor 's name,

and the system will display the message " Vendor not on   file--do you wish to add it?" When

you answer yes, the system immediately displays a vendor add screen. When you finish

entering the appropriate data, the system returns you to the bills payable function. This type of

feature, though not truly an accounting function, sure does make the system more

accommodating to the small-business environment. ". Note: The step of entering a vendor for an

invoice and finding that the vendor is not in the vendor file inherently includes the step of

searching the vendor in the vendor file. In White, vendor and vendor file corresponds to

merchant and master merchant file database as claimed). In view of White, it would have been

obvious to a person of an ordinary skill in the art at the time of the applicant's invention to have

modified Lawlor to incorporate White's teachings of searching a master merchant file database

to determine if information associated with one of the identified merchants is included in the

master merchant file database and adding information associated with the one identified

merchant to the master merchant file database if information associated with the one identified

merchant is determined not to be included in the master merchant file database.. Doing so

makes the system more convenient, efficient and faster as one does not have to exit from the

bill paying routine to update the master merchant filed database and then enter again the bill

paying routine.

Regarding claims 38, 39, and 40, all the limitations are already covered in claims 36

and 37, except for the limitation, receiving a plurality of payment records, and each of the

records identifying a merchant. Lawlor shows receiving a plurality of payment records, and each

of the records identifying a merchant (see at least col.10, line 66-col.11, line 15, "..*To use*

billpaying features, customers provide the service provider in advance with a list of payees

(names, account numbers, addresses). A typical household (owning an ATM card) writes 26

checks per month and the list might, for example include payments for: ...... utilities--telephone,

gas, water, electricity, cable TV; ..... residential--rent, mortgage, home, insurance; .....and

...miscellaneous--child care, tuition, church, vacation home, domestic employees, etc. ".

Therefore, claims 38, 39 and 40 are analyzed and rejected as being unpatentable over Lawlor in

view of White based on same rational as discussed for claims 36 and 37 above.

Regarding system claims 41-45, their intended functions correspond to the method

steps of claims 36-40 and are therefore analyzed and rejected as being unpatentable over

Lawlor in view of White on the basis of same rational. As regards system elements, network

interface, a storage device to store master merchant file database and a processor to execute

the intended functions Lawlor discloses them (see at least FIG.1 and col.17, lines 43-57.

Central computer system 52 with CPU-80 corresponds to the processor as claimed, Database

84 corresponds to the storage device as claimed, and the PDN switch 56, the packet

assembler/disassembler 58, the communications interface 60, and dialup telephone lines 62

correspond to the network interface as claimed.

Regarding an article of manufacture claims 46-50, their intended functions

correspond to the method steps of claims 36-40 and are therefore analyzed and rejected as

being unpatentable over Lawlor in view of White on the basis of same rational. As regards the

article of manufacture elements, a computer readable medium and computer programming

stored on the medium to execute the intended functions Lawlor discloses them (see at least

FIG.1 and col.17, lines 43-57. Central computer system 52 with CPU-80 with database 84 and

the PDN switch 56, the packet assembler/disassembler 58, the communications interface 60,

and dialup telephone lines 62 , etc...).

Conclusion

5.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as

set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date

of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
June 23, 2004